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EXAMINER

SWARTZ, JAMIE H

ART UNIT

PAPER NUMBER

3694

MAIL DATE

DELIVERY MODE

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

09/974,823

Applicant(s)

SHIMADA ET AL.

Examiner

Jamie H. Swartz

Art Unit

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,7-10,12,13 and 16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,7-10,12,13 and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 16, 2007 has been entered.
2. Claims 11, 14, and 15 have been cancelled.  
Claims 1, 10, 12, 13, and 17 have been amended.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The following features were not enabled in reference to digital contract information; management diagnosis, support of going public business, support of publicity work for investors and support of various settlements.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Regarding claim 1, the amended portion which states "receiving in the computer of said service provider a result of the consultation to be provided to the computer of said service beneficiary by preparing support information tempered with service intermediary business information by the computer of said service intermediary from the computer of said intellectual service cooperator and posting said consulting result to the computer of said service intermediary" makes the claim indefinite. Does the service intermediary receive the results of the consultation? How does the intermediary apply the information received into the report? Does the service provider transfer the results of the intellectual service cooperator to the service intermediary? Does the service cooperator have direct contact with the service intermediary?

8. Regarding claim 10, the claim states that the business management support service is using digital contract information to do various steps. Based on the specification the digital contract information consists of a service for members, a support application and a contract flag. Thus it is unclear based on the specification

which one of the support applications will be used, as the specification only states a singular support application.

9. Regarding claim 10, the claim states "various settlements." The word various makes the claim indefinite as various is not a specific term and does not attempt to limit the scope of the claim.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

11. Claims 1, 2, 9, 12, 13, 16 rejected under 35 U.S.C. 102(e) as being unpatentable over Broadbent et al (US 6904412 B1).

12. Regarding claim 1, 12, 13, Broadbent teaches a business management support method using computers of a service provider, a service beneficiary, a service intermediary, and an intellectual service cooperator attached to a network comprising *collecting enterprise information in said computer of said service provider from said computer of said service beneficiary* (col. 9, lines 8-20, col. 14, line 65 – col. 18, line 49, col. 48, line 49 – col. 49, line 26). The borrower uses a computer to input their personal data (col. 9, lines 34-38). Broadbent teaches *providing said collected enterprise information collected by the computer of said service provider to said computer of said intellectual service cooperator to make a request for consultation* (col. 9, lines 19-30 and col. 14, lines 18-26). Broadbent teaches *receiving in the computer of said service provider a result of the consultation to be provided to the computer of said service beneficiary by preparing support information tempered with service intermediary business information by the computer of said service intermediary from the computer of said intellectual service cooperator and posting said consulting result to the computer of said service intermediary* (col. 12, lines 24-34 and col. 14, lines 18-26, col. 8, lines 23-45, col. 14, line 65 – col. 18, line 49 and col. 48, line 49 – col. 49, line 26). Broadbent does Broadbent teaches how each party involved uses a computer (col. 14, lines 18-52).

13. Referring to claim 2, Broadbent teaches when a service intermediary is a bank which has dealings with said service beneficiary (col. 12, lines 24-34).

14. Referring to claim 9, while the specific names of the types of parties that would serve the intellectual service cooperator (i.e., an auditing corporation, a think tank, a securities firm, and a capital gain company) are not expressly disclosed by Broadbent, the specific names of the types of parties are mere labels. The particular names of the parties do not change the requesting or the information provided in claim 1 (from which claim 9 depends). As stated in claim 9, *an auditing corporation, a think tank, a securities firm and a capital gain company* are mere labels corresponding to the type of person performing the invention and such labels do not affect any recited structure or method. Analogous to the situation in *Ex parte Pfeiffer*, 135 USPQ 31 (BdPatApp&Int 1961) where structural limitations were not entitled to weight in method claims, the recited names of parties limitation therein must affect the method in a manipulative sense. In claim 9, since the recited names of parties does not affect the method in a manipulative sense, these specific names of parties do not patentably distinguish claim 9 over the prior art.

15. Referring to claim 12, Broadbent additionally teaches *a computer readable record medium having thereon recorded a business management support program to be run by a computer* (col. 7, lines 24-33). Further details of claim analysis is provided under the claim 1 rejection, especially as they apply to the commonly recited claim limitations.

16. Referring to claim 13, Broadbent additionally teaches a computer that acts as an *information collecting unit, a requesting unit, and an information providing unit* (col. 6 line 15 – col. 7 line 44).

17. Referring to claim 16, Broadbent teaches an *application service provider (ASP) including an ASP server collecting enterprise information* (col. 10, line 34-63, col. 16, line 7-23, col. 17, line 26-59, col. 46, line 10-51, col. 48, line 60 – col. 49, line 13). Broadbent teaches a *service beneficiary sending the enterprise information to said ASP server* (col. 10, line 34-63, col. 16, line 7-23, col. 17, line 26-59, col. 46, line 10-51, col. 48, line 60 – col. 49, line 13). Broadbent teaches an *intellectual service cooperator including an intellectual service cooperating server, and receiving, in said intellectual service cooperating server, said enterprise information from said ASP server, and providing a consultation in accordance with the received enterprise information* (col. 10, line 34-63, col. 16, line 7-23, col. 17, line 26-59, col. 46, line 10-51, col. 48, line 60 – col. 49, line 13). Broadbent teaches a *service intermediary including a bank server, and receiving, in said bank server, results of said consultation, and adding service information to the results, to create support information, and providing said support information to said service beneficiary* (col. 17, line 26 – col. 18, line 55, col. 35, line 30 – 63, col. 48, line 60 – col. 49, line 13).

**Claim Rejections - 35 USC § 103**



18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broadbent et al (US 6904412 B1), as applied to claim 1 above, in view of O'Flaherty et al (US 6253203 B1).

20. Regarding claim 7, Broadbent shows information collecting, requesting, consulting, and information providing but does not show predefined follow levels. O'Flaherty, however, shows a database *that depending on predefined follow levels, masking is effected in sequence on enterprise information collected in said collecting enterprise information, enterprise information provided to said computer of said intellectual service cooperator in providing said collected enterprise information, and the results of consultation on which said computer of said service beneficiary is posted in said posting the results.* (col. 7, line 1 – col. 10, line 55, col. 14, line 65 – col. 18, line 49 and col. 48, line 49 – col. 49, line 26) Also see figures 2A-3C. O'Flaherty specifically discusses banking, mortgages (col. 1, line 57-67), financial information (col. 10, line 2-6), and the use of databases (col. 2, lines 53-56). O'Flaherty states his invention serves to prevent abuse associated with accessing personal customer information (col. 2, lines 30-40). Broadbent's invention is related to mortgage processing using databases.

Similarly, O'Flaherty's invention is related to database security and references mortgages. It would have been obvious to a person of ordinary skill in the art at the time the invention to modify Broadbent to include the data column control for extra security with the information and for consumer privacy. This allows a company to avoid passing sensitive information to people without approved access while allowing maximum use of the system without a security leak/risk as suggested by O'Flaherty.

21. Regarding claim 8, Broadbent shows information collecting, requesting, consulting, and information providing but does not show various follow levels or masking. O'Flaherty, however, shows different dataviews which are provide different levels of visibility into the data in the customer table using masking. The privileged view (col. 8, lines 35-50) is *when said follow level is a maximum level, said enterprise information and said results of consultation are completely indicated without masking, and wherein the standard view (col. 8, lines 5-34) is when said follow level is a minimum level, masking is made on attribute information other than requisite items in said enterprise information and said results of consultation, and wherein the anonymizing view (col. 9, lines 4-12) is when said follow level is a level lying between said maximum level and said minimum level, said attribute information is indicated partially or in a simplified manner.* Broadbent's invention uses databases while O'Flaherty invention demonstrates a more sophisticated level of database security. Database security is more critical then ever now as networks have become more open. Database security exists as systems, processes, and procedures that protect a database from authorized

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misuse, malicious attacks or inadvertent mistakes made by authorized individuals or processes. Increased database security allows a company to avoid passing sensitive information to people without approved access while allowing maximum use of the system without a security leak/risk. It would have been obvious to a person of ordinary skill in the art at the time the invention to adapt Broadbent to have a maximum and minimum level of security on the information in a database to protect their customer's information (as taught by O'Flaherty), especially since Broadbent handles very confidential finance data of their customers.

22. Examiner's Note: The Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

23. Examiner would like to also bring the applicants attention to Inoue (US 20020091630 A1) and The Computer Lawyer (Jan 1999).


**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamie H. Swartz whose telephone number is (571) 272-7363. The examiner can normally be reached on 8:00am-4:30pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jamie Swartz  
August 20, 2007

  
ELLA COLBERT  
PRIMARY EXAMINER